submitted claim 10 is found in the originally filed specification at page 4, line 22 - page 5, line 6. It is therefore respectfully submitted that the above amendments do not introduce any new matter within the meaning of 35 U.S.C. § 132.

**Rejections of claims 1-9 under 35 U.S.C. § 103(a)**

The Examiner rejected claims 1-9 as obvious over U.S. Patent No. 6,144,457 to Higuchi in view of U.S. Patent No. 5,208,640 to Horie et al.

**Response**

Independent claims 1 and 7 have been amended to further differentiate the claimed invention over the cited prior art. As amended, the rejections of claims 1-9 are respectfully traversed.

Applicant traverses the rejections because all three prongs for a *prima facie* case of obviousness have not been established for each of the rejections. Specifically, as amended all the claim limitations are not present in the cited references and

one of ordinary skill in the art would have no motivation to modify the cited references into the present invention.

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) that some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) that the prior art references teach or suggest all the claim limitations. Amgen, Inc. v. Chugai Pharm. Co., 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); In re Wilson, 165 USPQ 494, 496 (C.C.P.A. 1970).

Moreover, Applicant submits that even assuming arguendo that such a combination of the cited references could be made, such combination would in fact yield an apparatus and a method different from the apparatus and method claimed in the present application.

The present invention, as claimed in independent claims 1 and 7, is directed to a printing machine (claim 1) and to a method of reporting an error in the printing machine (claim 7).

The printing machine comprises a plurality of image formation units for printing an image data, an error detection unit to detect an error occurring in the printing machine, and a computer readable ROM having a classified error table stored therein in which errors that can occur in the printing machine are classified. The table includes at least one error corresponding to a situation in which the printing operation of at least one image formation unit can be continued for the image data while the printing operation of another image formation unit must be halted, and at least one other error corresponding to another situation in which printing operations of all image formation units must be halted.

As claimed in claims 1 and 7, the printing machine of the present invention comprises a control unit which judges whether or not a detected error is an error corresponding to a situation in which the printing operation of at least one image formation unit can be continued for the image data while the printing operation of another image formation unit must be halted, or an error corresponding to another situation in which printing operations of all image formation units must be halted. In any

case, the control unit does not analyze the image data. The control unit only judges if the error information from the error detection unit is stored in the classified error table as either an error which halts at least one image formation unit while the other image formation units keep printing, or halts all of the image formation units. The outcome cannot be to hold or suspend the printing of a faulty image data, skip it, and print the next image data instead.

In contrast, in the print control apparatus and method disclosed by Higuchi, print information is sequentially received from a plurality of host computers via a plurality of input ports and analyzed by the print control apparatus. If the analysis performed by the print control apparatus determines that a given print information dataset contains an error that would possibly prevent the correct printing of that particular dataset but would not affect the printing of another dataset, then the printing of that particular dataset is put on hold and the next print information dataset is received from another computer through another input port and analyzed by the print control apparatus.

In the Higuchi patent, the control unit decides if a particular print information dataset can be printed whereas in the presently claimed invention the control unit decides if a particular print section can print.

It is therefore submitted that Higuchi does not teach a printing machine and a method of reporting an error in the printing machine in which at least one, or all of the image formation units in a plurality of image formation units are halted, depending on the nature of the error detected by an error detection unit in the printing machine.

Moreover, although the Horie et al. patent discloses "a plurality of recording modules" for "recording images" on "recording sheets P substantially simultaneously in a parallel mode" (col. 2, lines 17-21), the Horie et al. patent does not teach any kind of error detection unit, control unit or error judging step.

Neither Higuchi nor Horie et al. teach or suggest how to combine these two references to provide a printing machine and a method of reporting an error in the printing machine, as presently claimed in independent claims 1 and 7 of the present application.

The fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness (*MPEP §2143.01*). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the

way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

Additionally, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness (*MPEP §2143.01*). A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there

was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.).

Thus, it is submitted that it would not have been obvious to one of ordinary skill in the art to combine the teachings of Horie et al. with the teachings of Higuchi to provide a printing machine and a method of reporting an error in the printing machine, as presently claimed in independent claims 1 and 7 of the present application.

Moreover, even if the references could be combined, as asserted by the Examiner, it is submitted that the result would be different from the invention claimed in the present application. The combination suggested by the Examiner would be a printing machine receiving data from a plurality of host computers through a plurality of input ports. The print control apparatus would sequentially receive a variety of print

information datasets from the computers and would analyze each dataset to determine whether or not an error is present in said dataset and, if an error was present, would determine whether or not that error warrants halting the whole printing operation, or just requires suspending printing of the faulty dataset while continuing the analysis and printing of subsequent datasets.

In contrast, the present invention as claimed in claims 1 and 7 is directed to a printing machine comprising a plurality of image formation units, and a method of reporting an error in the printing machine comprising an error judging step of judging whether a detected error is either an error which halts at least one image formation unit while the other image formation units keep printing, or halts all of the image formation units.

Therefore, it is submitted that claims 1 and 7 are patentable over the cited prior art. Consequently, it is submitted that claims 2-6 and 9, which ultimately depend from claim 1 and claim 8, which ultimately depends from claim 7, are patentable over the cited prior art for at least the same reason that respectively claim 1 and claim 7 are patentable thereover.

Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

**NEWLY SUBMITTED CLAIM**

Newly submitted claim 10 is asserted to be patentable over the cited prior art for at least the same reasons that claim 1 is asserted to be patentable; and because, unlike the presently claimed invention, the Higuchi '457 patent starts processing of the next print information without completing the printing operation even if the error is the continuable error.

**MISCELLANEOUS**

The references cited by the Examiner have been reviewed and it is submitted that independent claims 1 and 7 as herein amended and resubmitted, and dependent claims 2-6 and 8-9 are patentable thereover.

**CONCLUSION**

In light of the foregoing, Applicant submits that the application is in condition for allowance. If the Examiner believes the application is not in condition for allowance,

Applicant respectfully requests that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

Respectfully submitted,

**NATH & ASSOCIATES PLLC**

Date: July 1, 2003

By: _____

Gary M. Nath
Registration No. 26,965
Harold L. Novick
Registration No. 26,011
Marvin C. Berkowitz
Registration No. 47,421
Customer No. 20529

NATH & ASSOCIATES PLLC
1030 Fifteenth Street, N.W.
Sixth Floor
Washington, DC 20005
(202) 775-8383